



RECEIVED
CENTRAL FAX CENTER
NOV 15 2004

I hereby Certify that this
Correspondence is being deposited with
the United States Postal Service as
First Class Mail in an envelope
addressed to: Commissioner for
Patents, P.O. Box 1450, Alexandria, VA
22313-1450 on September 21, 2004.

Martin G. Lihihan
Name
Signature

September 21, 2004
Date of Signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:

Barry C. Muffoletto et al.

Serial No.: 09/628,174

Group: 1775

Filed: May 1, 1997

Examiner: J. McNeil

For: METHOD FOR IMPROVING ELECTRICAL CONDUCTIVITY OF
METALS, METAL ALLOYS AND METAL OXIDES

REQUEST FOR REHEARING UNDER 37 CFR § 1.197(b)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Herewith is appellants' Request for Rehearing in triplicate
in response to the Decision on Appeal mailed July 21, 2004. The
grounds upon which appellants request rehearing are as follows.

Firstly, the Decision appears to have overlooked
application of the In re Luck decision, discussed in both the
Appeal Brief and Reply Brief of appellants, to the facts of this
case. A copy of the In re Luck decision is included herewith as

- 2 -

Exhibit A for convenience. In Luck the Court did consider the process limitation in the product claim at issue, and for that reason appellants urge that the process limitation should be considered here also. In particular, as set forth in the Opinion on pages 3 and 4 of the attached Luck decision, the Court did consider the process limitation in part d) of claim 1 when it made the statement:

But we do find that the Patent Office has established a prima facie case of obviousness for the product with full weight being given to the process limitation. The Pipkin and Crissey et al references specifically teach the use of an organic solvent. Hence such a solvent is an obvious alternative to the aqueous carrier of Boyd, no criticality having been taught by Boyd for the combination of silane and water.

Thus, in Luck the Court's determination of patentability of the product claim was "with full weight being given to the process limitation." The Court found the prior art of record relating to the subject matter of the process limitation to be determinative in deciding against patentability of the product claim. Here, if the Board were to consider the process limitation in the appealed claims 6 and 7, in a manner similar to what was done by the Court in Luck, the Board could reach no other decision but to find claims 6 and 7 patentable over the art of record. The prior art of record includes no disclosure, teaching or suggestion of a substrate having metal deposited thereon by low temperature arc vapor deposition in the manner claimed by appellants.

- 3 -

Appellants' position is believed to be consistent with MPEP § 2173.05(p) which states:

A product-by-process claim, which is a product claim that defines the claimed product in terms of the process by which it is made, is proper.

citing In re Luck. A copy of MPEP § 2173.05(p) is included herewith as Exhibit B. for convenience.

Secondly, the Decision appears to have overlooked the fact that the "objective evidence" referred to at the bottom of page 6 of the Decision does exist. The sentence on page 3, lines 12-14 of appellants' application:

The method can be performed at a temperature sufficiently low so as to prevent substrate degradation and deformation.

is believed to provide objective evidence supporting structural differences of appellants' claimed substrate as compared to the substrate of Evans. The significance of the fact that the substrate of appellants' invention does not require the heat treatment disclosed by Evans should be given full consideration. The substrate, oxide and applied ions of the Evans product have been heated at an elevated temperature (500 to 600°C) for a time (30 seconds to 1 minute) sufficient to incorporate the ions into the oxide layer. On the other hand, the product of appellants' invention has not been heated to such elevated temperature for such required time. It is reasonable to conclude that persons skills in the art would consider that a substrate product which has not been heated to such elevated temperature for such required time will be structurally different from one that has

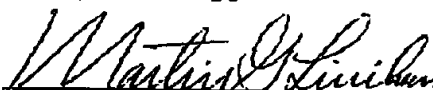
- 4 -

been so heated for such time. This is not merely argument because the above-quoted sentence from their application is evidence that appellants recognized that their substrate, which does not require the additional heat treatment of the prior art, is structurally different in not having substrate degradation and deformation. Such structural difference coupled with the advantages of the absence of such heat treatment establishes an unobvious difference between appellants' claimed product and the product disclosed by Evans.

For the reasons set forth above, appellants respectfully request the Board to reconsider its Decision of July 21, 2004 and reverse the 35 USC 102 rejection of record and find that claims 6 and 7 define patentable subject matter over the art of record.

Respectfully submitted,

HODGSON RUSS LLP
Attorneys for Appellants

By: 
Martin G. Linihan
Reg. No. 24,926

One M&T Plaza, Suite 2000
Buffalo, New York 14203-2391
(716) 848-1367
September 21, 2004

BFL00CS 964987v1 (X_L7011.DOC)